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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-----------------------|------------------|
| 10/699,724 | 11/03/2003 | Les Rosen | P00111.P2 | 3536 |
| 28778 | 7590 | 01/19/2006 | EXAMINER | |
| JOHNSON & STAINBROOK, LLP 3558 ROUND BARN BLVD., SUITE 203 SANTA ROSA, CA 95403 | | | OUELLETTE, JONATHAN P | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3629 | |
| DATE MAILED: 01/19/2006 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/699,724 | ROSEN, LES | |
| | Examiner | Art Unit | |
| | Jonathan Ouellette | 3629 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Claims 1 and 2 have been cancelled, and Claim 3-9 have been added; therefore, Claims 3-9 are now pending in application 10/699,724.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 3, 4, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Shapiro et al. (US 6,714,944 B1).**
4. As per **independent Claim 3**, Shapiro discloses a method for prospective employee to generate and maintain their own employment background report for potential subsequent submission to a prospective employer (C4 L61-67, C5 L1-13), said method comprising the steps of: providing an internet service with secure means for the prospective employee to create, edit, update, and reference a database of their employment and education history covering any time period (C7 L18-36); and

providing semi-automated means for verifying the employment and education history provided by the prospective employee (Fig.2, C1 L32-51, C6 L35-54).

5. As per Claim 4, Shapiro discloses providing a secure, confidential and private means for a prospective employer to review the verified employment and educational history of the prospective employee.
6. As per Claim 9, Shapiro discloses using a plurality of prospective employee records to build a verified database of workers.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
8. **Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shapiro et al. (US 6,714,944 B1).**
9. As per Claim 5, Shapiro discloses providing secure means for a prospective employee to create, edit, update, and reference a database of background information/history of the prospective employee covering any time period; and providing semi-automated means for verifying the background information/history provided by the prospective employee.

10. Shapiro fails to expressly disclose including licensing histories of workers in the background verification method.
11. However, Shapiro does disclose creating, editing and updating, verifying, and referencing a database of work and education histories, to include educational degrees and military ranks obtained by the user (C4 L61-67, C5 L1-13).
12. Furthermore, Official notice is taken that licensing histories of workers was a well-known component of worker history and employment background checking at the time the invention was made, as a way to ensure the integrity of the potential employees and verifying the necessary skill levels of potential employees.
13. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included licensing histories of workers, in the system disclosed by Shapiro, for the advantage of providing a method for creating, editing and updating, verifying, and referencing a user's background information, with the ability to increase the effectiveness of the method by including a plurality of background information to be verified.
14. Furthermore, these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The background verification method would be performed regardless of the type of background information verified. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

15. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have verified licensing histories of workers as part of the background check, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.
16. As per Claim 6, Shapiro discloses providing a secure, confidential and private means for a prospective employer to review the verified licensing history of the prospective employee.
17. **Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shapiro et al. in view of Backgrounds Online (www.backgroundsonline.com, Retrieved from Internet Archive Wayback Machine <www.archive.org>, Date Range: 4/27/1999-10/6/2000).**
18. As per Claim 7, Shapiro discloses providing secure means for a prospective employee to create, edit, update, and reference a database of background information of the prospective employee covering any time period; and providing semi-automated means for verifying the background information provided by the prospective employee.
19. Shapiro fails to expressly disclose providing means for reviewing verified criminal records history.
20. However, Backgrounds Online discloses verifying and providing for review a criminal record background check (www.backgroundsonline.com, pg.4 and 7).

21. Furthermore, Official notice is taken that the criminal histories of workers was a well-known component of worker history and employment background checking at the time the invention was made, as a way of ensuring the integrity of the potential employee and the safety of current employees.
22. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included providing means for reviewing verified a criminal records history, as disclosed by Backgrounds Online, in the system disclosed by Shapiro, for the advantage of providing a method for creating, editing and updating, verifying, and referencing a user's background information, with the ability to increase the effectiveness of the method by including a plurality of background information to be verified and saved for review.
23. As per Claim 8, *Shapiro* and Backgrounds Online disclose providing a secure, confidential and private means for a prospective employer to review the verified criminal record history of the prospective employee.

Response to Arguments

24. Applicant's arguments filed 11/10/05 have been considered, but are moot in view of the new ground(s) of rejection.
25. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

26. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
28. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (703) 872-9306 for all official communications.
29. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

Art Unit: 3629

JO

January 12, 2006


JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600